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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,246	04/26/2000	Nadia M. Corlett	9911-01	2384

7590 08/26/2003
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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,246

Applicant(s)

CORLETT, NADIA M.

Examiner

Jacqueline F Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,9,16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,9,16,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Status of Claims

1. Claims 11-15, 21, and 22 have been cancelled. Claims 1, 4, 5, 9, 16, 19, and 20 are pending.

Response to Arguments

2. Applicant's arguments filed 7/3/03 have been fully considered but they are not persuasive.

3. Regarding the Meixner reference, applicant argues that Meixner fails to teach or suggest packaging a single compressed absorbent article within a single packaging. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a single absorbent article in a single packaging) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, while Meixner provides a plurality of articles, it does an absorbent article as claimed. The 'comprising' language used in the independent claims is inclusive or open-ended and does not exclude additional unrecited elements, compositional components, or steps.

The argument that Meixner does not teach an absorbent article that is compressed and then packaged while compressed is not persuasive for claims 1-9. The steps of compressing the article and then packaging the article are product by

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process limitations. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113. Claims 1 is an apparatus claim that basically claims a compressed absorbent article, where the volume is reduced by 30%, and the article is retained by a packaging, which is anticipated by Meixner.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(s) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

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published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 4, 5, 9, 16, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Meixner USPN 6321513.

As to claims 1, 9, 16, and 20, Meixner discloses a highly compact and portable absorbent article comprising a packaging; and a compressed absorbent article reconfigured from a normal condition to a compressed condition; said absorbent article having three dimensions at least one of which is reduced when the absorbent article is in the compressed condition; the absorbent article occupying a volume of space that is reduced by at least about 30% when the absorbent article is reconfigured from a normal condition to a compressed condition (col. 4, lines 22-31), and the absorbent article being retained by the packaging.

As to claims 4, 5, and 19, Meixner discloses the absorbent article is reconfigured from a normal condition to a compressed condition by negative pressure, and the packaging is configured to retain at negative pressure the compressed absorbent article (col. 3, lines 46-63, col. 4, lines 22-32, col. 6, lines 4-12, and col. 9, lines 15-22).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4, 5, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer USPN 4936460 in view of DesMarais USPN 4110276.

Mayer discloses the article comprises a filler material made of polyester foam (col. 2, lines 67-68). Meyer shows all the features of the instant claimed invention except for Meyer does not specifically disclose the foam is absorbent. It is old and well known in the art that polyester foam is absorbent. Further, DesMarais shows a resilient polyester foam that is typically used in catamenial products, bandages, sponges, and furniture pads (Abstract, col. 2, lines 29-30, and col. 8, lines 27-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Meyer with a polyester foam as taught in DesMarais. The use of a polyester foam for resilient as well as absorbent properties is well known to those skilled in the art as taught by DesMarais.

Regarding claims 1 and 16, Meyer/DesMarais discloses a highly compact and portable absorbent article and a method for packaging absorbent articles comprising providing a portable set of compact absorbent articles **10**, comprising a plurality of compartments (Figure 1) comprising a packaging **18** and a toy made of resilient polyester foam filler material (col. 2, lines 67-68). The absorbent article is reconfigurable from a normal to a compressed condition in which the absorbent article is reduced by at least one dimension (Abstract). Meyer/DesMarais does not disclose the article occupies a volume of space, which is reduced by at least about 30% when the article is reconfigured from a normal to a compressed condition. Meyer/DesMarais discloses the

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article is reduced by 20% (Abstract, col. 1, lines 29-33). However, unless applicant can show criticality for claiming a particular particle size, it is not novel to claim a specific size. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Regarding claim 4, Meyer/DesMarais discloses the packaging is configured to retain at negative pressure the compressed absorbent article (col. 1, lines 28-33).

Regarding claim 5, Meyer/DesMarais discloses the absorbent article is reconfigured from a normal condition to a compressed condition by negative pressure (col. 2, lines 33-37).

Regarding claim 19, Meyer/DesMarais discloses the packaging is configured to retain at negative pressure the compressed absorbent article (col. 1, lines 28-33).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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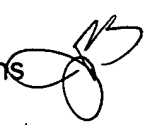
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Jacqueline F Stephens
Examiner
Art Unit 3761



WEILUN LO
SUPERVISORY PATENT EXAMINER
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August 20, 2003